

REMARKS

Claims 1-44 are pending in this application. Claims 1-44 have been rejected. The following claim rejections have been asserted: Claims 1-5, 8-11, 32-33 and 36-39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,999,970 to Krisbergh et al. in view of U.S. Patent 6285407 to Yasuki; Claims 6 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Krisbergh in view of Yasuki and further in view of U.S. Patent No. 6,141,356 to Gorman; Claims 12-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Krisbergh in view of Yasuki and further in view of U.S. Patent No. 5,561,703 to Arledge et al.; Claims 15-16 and 41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Krisbergh in view of Yasuki and further in view of U.S. Patent No. 5,991,596 to Cunningham et al.; Claims 17-18 and 42-43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Krisbergh in view of Yasuki and further in view of U.S. Patent No. 6,320,941 Tyroler; Claims 19-22, 26-28, 34-35 and 44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Krisbergh in view of Yasuki and further in view of U.S. Patent No. 6,263,501 to Schein et al.; Claims 23-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Krisbergh in view of Yasuki and further in view of Schein and further in view of U.S. Patent No. 5,812,931 to Yuen et al.; Claim 25 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Krisbergh in view of Yasuki and further in view of Schein and further in view of Yuen and further in view of Arledge; and Claims 29-31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Krisbergh in view of Yasuki and further in view of Schein and further in view of Cunningham.

To establish a *prima facie* case of obviousness, various criteria must be met. For instance, there must be some *suggestion or motivation* in these references or in the knowledge

generally available to one skilled in the art *to combine the teachings of these references*. In addition, the references *must teach or suggest all the claim limitations*. The teaching or suggestion to make the claimed combination must both be found in the prior art and not hindsight reasoning based on applicant's disclosure (see, e.g., MPEP 2141, 2143, 2143.03).

It is respectfully submitted that at the very minimum, the combination of Krisbergh and Yasuki is legally deficient to establish a *prima facie* case of obviousness against claims 1, 32 and 36. For example, the combination of Krisbergh and Yasuki does not disclose or suggest *at least a first communication unit, operatively coupled to a television set, having a central processing unit, a mass storage device, and a signal combiner, for generating at least one information signal and for generating and displaying at least one display signal superimposed on a conventional television signal on the television set*, as essentially claimed in claims 1, 32 and 36.

Indeed, Examiner acknowledges that Krisbergh does not disclose such feature. However, although Yasuki arguably discloses a combiner, Yaskuki discloses that the combiner is part of a TV receiver of a television set. Therefore, Yasuki does not disclose or suggest, *a communication unit, which is connected to a television set, that has the claimed functions and components, as recited in claims 1, 32 and 36*. One advantage of the present invention is that a communication device can be coupled to a conventional television set (which essentially acts and a display device). Yasuki, in contrast, essentially discloses an Internet TV having a multi-function TV receiver that extracts network signals from a television signal.

Examiner's contention that it would have been obvious to modify Krisbergh with the teachings of Yaskuki to "provide a multi function TV receiver" **respectfully misses the point**. In the claimed inventions, the *first communication unit, operatively coupled to a television set, and the second communication unit* are not TV receivers, such as the devices of Krisbergh and

Yaskuki. In stark contrast, Krisbergh teaches a set-top box that acts as a TV signal processor/tuner which extracts information signals from the vertical blanking intervals embedded in TV signals. Further, Yasuki teaches a multi-function TV receiver that also extracts information signals embedded in TV signals. Thus, both the Krisbergh and Yasuki systems are intimately related and associated with TV signal processing. This actually teaches away from the claimed inventions because the communication units, as recited in claims 1, 32 and 36, do not act as TV receivers/tuners that extract signals embedded in TV signals. Therefore, one of ordinary skill in the art would not necessarily rely on, or be motivated by, the teachings of Krisbergh and Yasuki, with respect to the claimed inventions.

Therefore, for at least the above reasons, claims 1, 32 and 36 are believed to be patentable and non-obvious over the combination of Krisbergh and Yasuki.

Furthermore, since the remaining claim rejections of all dependent claims are based, in part, on the combination of Krisbergh and Yasuki as applied to claims 1, 32 and 36, such rejections are believed to be legally deficient for at least the above reasons given for claims 1, 32 and 36. Thus, withdrawal of the claim rejections under 35 U.S.C. § 103 is respectfully requested.

Respectfully submitted,



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